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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,767	04/16/2004	Thomas M. Conway	6570-91244	1286
24628	7590	08/03/2006	EXAMINER	
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606				STERLING, AMY JO
		ART UNIT		PAPER NUMBER
		3632		

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/826,767	CONWAY ET AL.
	Examiner	Art Unit
	Amy J. Sterling	3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 June 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6,8-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4 and 8-12 is/are rejected.
- 7) Claim(s) 5,6,13,14 and 16 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 June 2006 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

This is a non-final Office Action for application number 10/826,767 Bias Assisted Sign with Floating Mount System, filed on 4/16/04. Claims 1-6, 8-14 and 16 are pending. This non-final Action is in response to applicant's reply dated 6/22/06. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites that "the upper and lower mount portions mounted to the spine...having a biasing element securing portion" and "the upper and lower arms...having a biasing element securing portion". It is understood from the Reply dated 6/22/06 that these are indicated as two separate elements 42, and 46. The claim is considered indefinite because it is unclear that this limitation represents two separate elements. The applicant is required to change the name in order to clarify. For example, the upper and lower spine may have a first biasing element securing portion and the arms may have a second biasing securing portion. The specification must also be changed for clarification.

Claims 1 and 9 recite the limitation "the latch fastener". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 2787433 to Slavsky et al.

The patent to Slavsky et al. discloses a sign mounting system having a face having a plurality of vertically extending, spaced apart openings, the mounting system having a spine (10) adapted to mount to the vertical post, the spine have a face portion, upper and lower mount portions (11, 12) mounted to the spine, at least one of the upper and lower mount portions having a biasing element securing portion (pivot bolt) an upper arm (14) and a lower arm (15) mounted to respective upper and lower mount portions, the upper and lower arms (14, 15) each having a pivot portion defining a pivot

axis (straight through pivot bolt) about the mount portion, the pivot axes being collinear, at least one of the upper and lower arms having a biasing element securing portion (the pivot bolt) a biasing element (20, 21) operably connecting the upper or lower arm to its respective mount portion at the respective biasing element securing portions, wherein the arm is pivotal between first and second positions and is biased toward the first and second positions by the biasing element; and a floating insert (1, 6, 7, 8) for mounting the spine to the upright, the floating insert having a body portion (1, 7) for engaging the spine and the upright and for spacing the spine face from the upright face, the floating insert having a latch portion (8, 6) having a threaded stud disposed in the body portion, the latch portion engageable with the upright the latch portion including a threaded stub fastener (6, 8) extending therefrom wherein when the floating insert is engaged with the upright and the latch fastener is engaged with the spine, the spine is secured to the upright with the face portion of the spine spaced from the face of the upright, wherein the floating insert includes a central support portion (7) and depending legs (8) extending from the central support portion and tabs on the legs urged inwardly toward one another (See ends of legs), the tabs which could also be defined as a finger and a first hook element spaced from one another and opposingly oriented, wherein the latch portion fastener is a threaded stub (6) and wherein the floating insert body portion includes an opening for receiving the threaded stub.

Response to Arguments

The applicant has argued that there is sufficient antecedent basis for the "latch fastener" of claims 1 and 9, but this is unpersuasive in that the "latch fastener" is not considered clearly the same language as the "latch having a fastener" and the terminology must be changed in order to match.

The rejection has been redefined with the same prior art. The action is made non-final to give the applicant a chance to fully respond.

Allowable Subject Matter

Claim 5, 6, 13, 14 and 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication should be directed to Amy J. Sterling at telephone number 571-272-6823. The examiner can normally be reached (M-F 8 a.m.-5:00 p.m.). The fax machine number for the Technology center is 571-273-8300 (formal amendments) or 571-273-6823 (Informal communications). Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist at 571-272-3600


Amy J. Sterling
7/28/06